

REMARKS

In the Office Action mailed March 21, 2005, the Examiner rejected claims 1, 3, 6, 9, 9, 13 and 22-38. By way of the foregoing amendments and the markings to show changes, please amend claims 1, 3, 6, 8, 9, 13, 23-26 and 28-37, cancel claim 22 and add new claims 39-41. The foregoing amendments are taken in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicant would otherwise be entitled in view of the prior art.

I. Drawings

The Office Action suggested that Applicant needs to submit drawings showing primer and a layer of paint. In response, Applicant resubmits the same drawing (replacement drawing with amended Fig. 4) that was submitted in Response to the original non-final Office Action issued for the present application. As was suggested by the final Office Action issued for the present application, such drawing can be entered and Applicant now requests that it be entered. Moreover, Applicant additionally amends the specification to reference the layer of primer and the layer of paint. No new matter has been added. Upon approval of the replacement drawings, Applicant will have that drawing formalized.

The Office Action also suggested that welds should be shown for claims 25, 26, 27, 28, 29 and 38. However, the language in each of those claims suggests that there is "less than" a certain number of welds. Such language, in addition to including various numbers of welds, also includes zero welds and, as such, Applicant contends that the drawings show at least an embodiment of that which is claimed.

II. Rejections under 35 USC 112

The Office Action rejected claims 3, 6, 8, 9, 13 22-26 and 28-37 suggesting that "An attachment" should be "The attachment". To expedite prosecution, Applicants have made such changes.

III. Rejections under 35 USC 103

The Office Action rejected claims 1, 3, 6, 8, 9, 13 and 22-38 as being obvious in view of one or both of Brodt et al. (6,027,160) and Ligon et al. (5,358,397). Applicant traverses each of these rejections and suggests that these claims are patentable over the references of record as originally submitted. To expedite prosecution, Applicant has amended claim 1. Applicant contends that the language added to claim 1 clarifies the patentability of claim 1 relative to the references of record. As such, Applicant requests an indication of allowability of claim 1 and its dependents.

Applicant traverses the rejection of claims 27-38 with particularity. Applicant has not amended claims 27-38 other than, for some of the claims, to address the 35 USC 112.

Applicant traverses the rejection of claims 27-38 on the grounds that the Office Action of March 21, 2005 does not establish a prima facie case of obviousness against claims 27-38 for several reasons discussed in detail below.

As stated in the MPEP 2143.03, "To establish prima facie obviousness...all the claim limitations must be taught or suggested by the prior art." In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, the MPEP states that, "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

The Court of Appeals for the Federal Circuit, in the case of In re Lee, 61 USPQ2d 1430 (CAFC 2002), wrote:

The factual inquiry whether to combine references must be thorough and searching." Id. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris Inc., 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a

suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding') (quoting C.R. Bard, Inc., v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.");...

The need for specificity pervades this authority. See, e.g., In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

Claim 27

In rejecting claim 27, the Office Action admits that Brodt et al. does not disclose less than 20 welds and a layer of primer and a layer of paint over the adhesive. The Office Action suggests that "less than 20 welds" and "a layer of primer and a layer of paint over the adhesive" would have been obvious because, "it has been held to be within the general skill of a worker in the art...to select a known and commercially available method of attachment on the basis of its suitability to achieve the desired strength for the attachment system ..." and the Office Action also suggests that "a layer of primer and a layer of paint over the adhesive" would have been obvious because, "it has been held to be within the

general skill of a worker in the art to protect the articles exposed to various conditions."

Applicant contends that this rejection fails to establish a prima facie case of obviousness because: i) The rejection does not show the elements of claim 27 in the prior art; ii) Since the rejection does not show the elements in the prior art, the rejection also fails to provide any motivation for the skilled artisan to combine elements to form Applicant's invention; and iii) The apparent allusion to precedent by the Office Action is unsubstantiated.

The law cited above has established that the formation of a proper obviousness rejection requires, by the USPTO, a showing of all the elements of a claim in the prior art and, additionally, a motivation for combining these elements as recited in the claims. The statements in the Office Action regarding the "general skill of a worker in the art" are merely conclusory. The statements do not establish the existence of "less than 20 welds" or "a layer of primer and a layer of paint over the adhesive" in the prior art. As such, the Office Action has failed to establish a prima facie case of obviousness against at least claims 27 and its dependents.

Additionally, the Office Action does not establish a proper motivation for combining the aforementioned elements with the other elements of claim 27. The Office Action provides no specific reason or motivation as to why the skilled artisan would be motivated to combine the aforementioned elements with an attachment system involving a roof panel of an automotive vehicle or any of the other elements of claim 27. As such, Applicant contends that the Office Action has asserted an obviousness rejection based upon impermissible hindsight. This use of impermissible hindsight becomes particularly pointed since the material 14 of Brodt et al. (as used by the Office Action to reject claim 27) is located in an area that would make it unlikely for that material 14 to be covered by paint or primer. Again, the Office Action has failed to establish a prima facie case of obviousness against claim 27 and its dependents.

Lastly, the Office Action, in making the aforementioned conclusory statements about the obviousness of claim 27, has prefaced those statements with

the phrase “it has been held” thereby making an allusion to legal precedent. Applicant suggests, however, that the allusion to precedent is unsubstantiated since it provides no particularly caselaw or case cites. Moreover, Applicant contends that any later citation of particular caselaw would be seen as a new grounds of rejection since Applicant was not afforded the opportunity to address such caselaw.

Based on the above, Applicant respectfully requests that the rejection of claim 27 and its dependent be withdrawn.

Claims 28-29

Claims 28-29 respectively recite the phrases “less than 10 welds” and “less than 5 welds”. The Office Action rejects these claims on the same grounds as it rejected the phrase “less than 20 welds” in claim 27. As such, Applicant traverses the rejection of claims 28-29 for the same reasons as discussed in relation to claim 27.

Claim 30

Claim 30 recites that the, “structural adhesive material has a tensile strength of at least 12 MPa.” The Office Action rejected claim 30 suggesting that “it has been held to be within the general skill of a worker in the art (see specification paragraph 000037 – One exemplary expandable material ...) to select a known and commercially available material on the basis of its suitability for the intended use ...”

Applicants contend that the Office Action rejection fails to assert a prima facie case of obviousness because: i) The rejection does not show the elements of claim 30 in the prior art; ii) Since the rejection does not show the elements in the prior art, the rejection also fails to provide any motivation for skilled artisan to combine elements to form Applicant's invention; and iii) The apparent allusion to precedent by the Office Action is unsubstantiated.

The law cited above has established that the formation of a proper obviousness rejection requires, by the USPTO, a showing of all the elements of a

claim in the prior art and, additionally, a motivation for combining these elements as recited in that claim. The statement in the Office Action regarding the “general skill of a worker in the art” is merely conclusory. The statement does not establish the existence of a “structural adhesive material [that] has a tensile strength of at least 12 MPa” in the prior art. Instead of establishing such existence, the Office Action improperly points to Applicant’s disclosure to establish the existence of such a material thereby violating the legal precedent that states, “To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” See Site Corp. v. VSI International Inc., 50 USPQ2d 1161, 1171 (CAFC 1999) referencing W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). As such, the Office Action has failed to establish a prima facie case of obviousness against at least claim 30 and its dependents.

Additionally, the Office Action does not establish a proper motivation for combining the aforementioned element with the other elements of claim 30. The Office Action provides no specific reason as to why the skilled artisan would be motivated to combine the adhesive material with an attachment system involving a roof panel of an automotive vehicle or any of the other elements of claim 30. At best, the Office Action provides generalized reasoning as to why Applicant for the present application created the invention of the present application. As such, Applicant contends that the Office Action has asserted an obviousness rejection based upon impermissible hindsight. Again, the Office Action has failed to establish a prima facie case of obviousness against claim 30 and its dependents.

Lastly, the Office Action, in making the aforementioned conclusory statement about the obviousness of claim 30, has prefaced the statement with the phrase “it has been held” thereby making an allusion to legal precedent. Applicant suggests, however, that the allusion to precedent is unsubstantiated since it provides no particularly caselaw or case cites. Moreover, Applicant contends that any later citation of particular caselaw would be seen as a new grounds of

rejection since Applicant was not afforded the opportunity to address such caselaw.

Based on the above, Applicant respectfully requests that the rejection of claim 30 and its dependent be withdrawn.

Claim 31-34

The Office Action has ignored the language presented in claims 31-34. As such, according to the law recited above, the Office Action has failed to establish a prima facie case of obviousness against claims 31-34. Applicant therefore respectfully request that the rejections of claim 31-34 be withdrawn.

Claim 35

The Office Action rejects claim 35 in the exact same manner as it rejected claim 30 with the exception that the Office Action cites to another portion of Applicant's disclosure for making the rejection. As such, Applicant traverse the rejection of claim 35 on the same grounds as the traversal of claim 30 and Applicant requests that the rejection of claim 35 be withdrawn.

Claim 36-37

The Office Action has ignored the language presented in claims 36-37. As such, according to the law recited above, the Office Action has failed to establish a prima facie case of obviousness against claims 36-37. Applicant therefore respectfully request that the rejections of claim 36-37 be withdrawn.

Claim 38

The rejection of claim 38 fails to establish a prima facie case of obviousness for the reasons discussed in regard to claims 27-37. As such, Applicant respectfully requests that the rejection of claim 38 be withdrawn.

IV. New Claims

Applicant has added new claims 39-41 to address various aspect of the present application. Applicant contends that dependent claims 39-41 are patentable based upon the independent claims upon which they are dependent and based upon the language of the dependent claims themselves.

Moreover, Applicant points out that it would likely be improper to present a final rejection of claims 27-38 on a grounds alternative to that already presented since applicants have not amended claims 27-38 in a manner, which would necessitate such alternative grounds. In particular, the MPEP reads:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee..." MPEP 706.07(a)

Thus, any new grounds of rejection, "that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee..." would be improper.

By amending the application, the Applicants do not concede that the patent coverage available to them would not extend as far as the original claim. Rather, Applicants intend to file a continuation application to pursue the breadth of the claims as filed. Applicants believe that the Examiner has not made a sufficient showing of inherency of the teachings of the asserted prior art, especially given the lack of teachings in the cited references of the properties that Applicants have recited in their claims.

Further, by the present amendment, it does not follow that the amended claims have become so perfect in their description that no one could devise an equivalent. After amendment, as before, limitations in the ability to describe the

present invention in language in the patent claims naturally prevent the Applicants from capturing every nuance of the invention or describing with complete precision the range of its novelty or every possible equivalent. See, Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 62 USPQ2d 1705 (2002). Accordingly, the foregoing amendments are made specifically in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicants would otherwise be entitled.

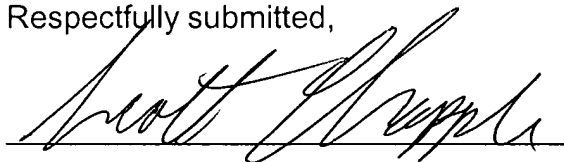
CONCLUSIONS

In view of Applicants' amendments and remarks, the Examiner's rejections are believed to be rendered moot. Accordingly, Applicants submit that the present application is in condition for allowance and requests that the Examiner pass the case to issue at the earliest convenience. Should the Examiner have any question or wish to further discuss this application, Applicant requests that the Examiner contact the undersigned at (248) 292-2920.

If for some reason Applicant has not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent the abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge our Deposit Account No. 50-1097 for any fee which may be due.

Dated: 27 April, 2005

Respectfully submitted,



Scott Chapple
Registration No. 46,287
DOBRUSIN & THENNISCH PC
29 W. Lawrence Street
Suite 210
Pontiac, MI 48342
(248) 292-2920

Customer No. 25215